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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,742	02/02/2005	Gerardus De Keyser	ELI2-22733/A/PCT	2467
324	7590	11/28/2008	EXAMINER	
JoAnn Villamizar			KUGEL, TIMOTHY J	
Ciba Corporation/Patent Department			ART UNIT	
540 White Plains Road			PAPER NUMBER	
P.O. Box 2005			1796	
Tarrytown, NY 10591			MAIL DATE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,742

Applicant(s)

KEYZER ET AL.

Examiner

Timothy J. Kugel

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9, 10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 and 12-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 1-10 and 12-15 are pending as amended on 10 November 2008, claims 11 and 16 being cancelled. Claims 5 and 8 are withdrawn from consideration.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

Response to Amendment and Argument

3. Applicant's amendment to independent claim 1, excluding zinc from the potential central metal atoms in Formula I, has been fully considered and overcomes the following:

The rejection of claims 1-4, 6, 7, 9, 10 and 12-15 under 35 USC § 103(a) as being unpatentable over US Patent Application Publication 2002/0045111 (Machiguchi hereinafter) in view of Hu, Mougang et al., "Hydroxyphthalocyanines as Potential Photodynamic Agents for Cancer Therapy", Journal of Medicinal Chemistry (1998), 41(11), 1789-1802 (Hu hereinafter) has been withdrawn.

4. It is noted that applicant has made no argument regarding the outstanding rejection of claims 1-4, 6, 7, 9, 10 and 12-15 under 35 USC § 103(a) as being unpatentable over Machiguchi in view of applicant's admission as detailed in the previous Office action and restated below.

Claim Rejections - 35 USC § 103

5. Claims 1-4, 6, 7, 9, 10 and 12-15 stand rejected under 35 USC § 103(a) as being unpatentable over US Patent Application Publication 2002/0045111 (Machiguchi hereinafter) in view of applicant's admission.

Machiguchi teaches a color filter having equal areas of three colors (Figure 2), wherein the green filter area has a large transmittance at a wavelength of 535 nm (¶¶0010 and 0019) wherein the green filter comprises a phthalocyanine compound similar to that of Formula (I) instantly claimed except having sulfur-containing substituents (¶¶0047-0064) and further comprising a yellow dye (¶0077) wherein the dyes are dispersed within an alkali-soluble resin—which reads on the high molecular weight material instantly claimed—in ratios of from 3 to 55 parts per weight resin per 100 parts dye (¶0101).

Machiguchi does not disclose expressly a phthalocyanine compound having the same substituents—for example -OH substituents as instantly claimed.

Applicant admits that “The instant compounds of Formula (I) are partially known, partially new. Those which are new can be made easily in analogy to known methods” (Instant Specification Page 4 Lines 8-9). Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made to include the compounds of Formula (I) in the filter of Machiguchi.

6. Claims 1-4, 6, 7, 10 and 12-15 are rejected under 35 USC § 103(a) as being unpatentable over US Patent Application Publication 2002/0045111 (Machiguchi

hereinafter) in view of M. P. Somashekarappa et al, "Synthesis and Structural Studies on 1,8,15,22-Tetrahydroxy Phthalocyanines of Co(II), Ni(II), Cu(II) and Zn(II)", Oriental Journal of Chemistry, Volume 15(1), 65-70, 1999.

Machiguchi teaches a color filter having equal areas of three colors (Figure 2), wherein the green filter area has a large transmittance at a wavelength of 535 nm (¶¶0010 and 0019) wherein the green filter comprises a phthalocyanine compound similar to that of Formula (I) instantly claimed except having sulfur-containing substituents (¶¶0047-0064) and further comprising a yellow dye (¶0077) wherein the dyes are dispersed within an alkali-soluble resin—which reads on the high molecular weight material instantly claimed—in ratios of from 3 to 55 parts per weight resin per 100 parts dye (¶0101).

Machiguchi does not disclose expressly a metal phthalocyanine compound having the same substituents—for example -OH substituents as instantly claimed.

Somashekarappa discloses a phthalocyanine blue-green pigment (Page 65 ¶1) having four hydroxy substituents as instantly claimed and Co, Ni or Cu as the central metal (Figure 1, Page 68).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the hydroxy-substituted Co-, Ni-, or Cu-phthalocyanine dye of Somashekarappa in the filter of Machiguchi. The rationale to do so would have been the motivation provided by the teaching of Somashekarappa that such dye would be blue-green in color and further since it has been held that it is *prima facie* obviousness to use a known material based on its suitability for its intended use (*Sinclair & Carroll*

Co. v. Interchemical Corp., 325 US 327, 65 USPQ 297 (1945), *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988)).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Regarding the X-references cited on the International Search Report for PCT/EP03/08654 that were not relied-upon:

Guo, L. et al.: "Ligand Substitution Effect on Optical Properties in Conducting Tetraazaporphyrines", Materials Research Society Symposium Proceedings, Materials Research Society, Pittsburg, PA, US, vol. 393, 1995, pages 137-142 (Guo hereinafter teaches a similar compound to the instantly claimed Formula I, including nickel as the central metal atom, but teaches hydroxyl groups on R14 and R15 as excluded by the instant claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached on 5:30 AM - 4:00 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/
Primary Examiner, Art Unit 1796